

The opinion in support of the decision being entered today is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte URS HOELZLE, MONIKA H. HENZINGER, and
LAWRENCE E. PAGE

Appeal 2007-1316
Application 09/734,886
Technology Center 2100

Decided: August 9, 2007

Before LEE E. BARRETT, ANITA PELLMAN GROSS,
and JOHN A. JEFFERY, *Administrative Patent Judges*.

GROSS, *Administrative Patent Judge*.

DECISION ON APPEAL
STATEMENT OF THE CASE

Hoelzle, Henzinger, and Page (Appellants) appeal under 35 U.S.C.
§ 134 from the Examiner's rejection of claims 1 through 61, which are all of
the claims pending in this application.

Appellants' invention relates generally to a hypertext browsing assistant. Claims 1 and 25 are illustrative of the claimed invention, and they read as follows:

1. A computer-implemented method for performing a search, comprising:

obtaining selection of one or more groups of characters in a document currently accessed by a user, the obtaining comprising:

highlighting the one or more groups of characters in the document, and

selecting a search object while the one or more groups of characters are highlighted in the document;

generating a search query using the selected one or more groups of characters in response to selecting the search object;

retrieving search results based on the search query; and

presenting the search results to the user.

25. A method for prefetching documents associated with a search, comprising:

identifying a document that includes one or more links, each of the links corresponding to a linked document;

analyzing each of the links in the document;

determining a score for each of the links; and

prefetching a number of the linked documents corresponding to a number of the links based on the determined scores.

The prior art reference of record relied upon by the Examiner in rejecting the appealed claims is:

Kleinberg US 6,112,202 Aug. 29, 2000

Claims 1 through 6 and 9 through 24 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

Claims 1 through 6 and 9 through 24 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claims 1 through 6 and 9 through 24 stand rejected under 35 U.S.C. § 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements.

Claims 1, 3 through 7, 9 through 12, 14 through 33, and 35 through 45 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Kleinberg.

Claims 2, 8, 13, 34, and 46 through 61 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kleinberg.

We refer to the Examiner's Answer (mailed October 3, 2006) and to Appellants' Brief (filed July 18, 2006) for the respective arguments.

SUMMARY OF DECISION

As a consequence of our review, we will affirm the enablement and indefiniteness rejections of claims 1 through 6 and 9 through 24. However, we will reverse the completeness rejection of claims 1 through 6 and 9 through 24. Further, we will reverse the anticipation rejection of claims 1, 3 through 7, 9 through 12, 14 through 33, and 35 through 45 and also the obviousness rejection of claims 2, 8, 13, 34, and 46 through 61. We also enter new grounds of rejection of claims 1 through 24 under 35 U.S.C.

§ 112, first paragraph, as failing to satisfy the written description requirement and of claims 7 and 8 under 35 U.S.C. § 112, first and second paragraphs, as failing to satisfy the enablement requirement and as being indefinite, respectively.

OPINION

The Examiner asserts (Answer 3) that the Appellants do not define the phrase "search object" in the Specification, and, thus, "its relationship to highlighted characters is not set forth in an enabling manner." Appellants contend (Br. 17) that "it is quite clear that the search object corresponds to, for example, a toolbar object, a software button, or a menu item." Appellants contend that the Specification clearly indicates that once words are highlighted in a document, the user selects a toolbar object, a software button, or a menu item to cause the highlighted words to be selected by the browser assistant to perform a search. The first issue, therefore, is whether the Specification enables the phrase "search object."

We first note that the term "search object" does not appear in the Specification. From claim 1, for example, we know that the search object is something that is *selected* after words in a document are highlighted but before a search query is generated. Looking to the Specification, we find that the process for initiating a search begins on page 11. The user selects a word, phrase, paragraph, or entire document for a search (Specification 11:16-19). If a word is selected, the user highlights the selection by clicking on the word, positioning a pointer over the word, or using a conventional method (Specification 11:20-21). Similarly, to select a phrase or paragraph, the user highlights the words. To select an entire document for highlighting,

the user selects a software button or menu item provided by the browser assistant (Specification 11:21-12:3). Next, the browser assistant analyzes the words, phrases, paragraphs, or document selected and generates a search query either from the words themselves or from a main concept of the paragraph or document (Specification 12:4-13:10). Thus, the only *selection* disclosed before generating the search query is the selection of a software button or menu item to highlight an entire document. In other words, contrary to Appellants' contention (Br. 17), the disclosed selection of the software button or menu item cannot be the claimed search object as it occurs prior to highlighting the characters in the document, not while the characters are highlighted. Therefore, we will sustain the enablement rejection of claims 1 through 6 and 9 through 24.

The Examiner asserts (Answer 4) that the phrase "search object" in the claims is unclear as it is not a term of art and is not defined in the Specification. Appellants contend (Br. 18-20) that the term "search object" is clearly defined in the Specification and that the second paragraph rejection should, therefore, be withdrawn. The issue before us is whether the term "search object" renders claims 1 through 6 and 9 through 24 indefinite.

As indicated *supra*, the phrase "search object" is neither used nor defined in the Specification. Furthermore, as explained by the Examiner, the phrase "search object" is not a term of art, and Appellants have not provided a definition that is supported by the Specification. Therefore, since the phrase "search object" is unclear, claims 1 through 6 and 9 through 24, all of which include that phrase, are indefinite.

The Examiner (Answer 4-5) further rejects claims 1 through 6 and 9 through 24 under 35 U.S.C. § 112, second paragraph, "as being incomplete for omitting essential structural cooperative relationships of elements." Specifically, the Examiner asserts (Answer 5) that Appellants have failed to claim the relationship between the search object and the highlighted groups of characters. Appellants contend (Br. 23-24) that claim 1 clearly recites the relationship between the search object and the highlighted characters, since claim 1 recites selecting the search object while the characters are highlighted. Accordingly, the issue is whether the claims recite the essential cooperative relationships of elements.

We agree with Appellants that the relationship between the search object and the highlighted characters is clear in the claims. Specifically, the search object is selected while the characters are highlighted. Consequently, we cannot sustain the rejection of claims 1 through 6 and 9 through 24 under 35 U.S.C. § 112, second paragraph, as being incomplete.

Next, the Examiner asserts (Answer 5) that claims 1, 3 through 7, 9 through 12, 14 through 33, and 35 through 45 are anticipated by Kleinberg. As to claims 1, 9, and 18 through 24 Appellants contend (Br. 25-30 and 41-60) that Kleinberg fails to disclose highlighting characters in a document, selecting a search object while the characters are selected, and generating a search using the selected characters. Appellants contend (Br. 30-41) that claims 3 through 7, 10 through 12, and 14 through 17 are not anticipated because of their dependency from claim 1 as well as for their further limitations. The next issue, therefore, is whether Kleinberg discloses

highlighting characters in a document and selecting a search object¹ while the characters are selected.

As stated by the Examiner (Answer 6), Kleinberg discloses (col. 2, l. 49-col. 3, l. 4) highlighting words or phrases in a Web page that are configured as a hyperlink. Selection of the words or phrases downloads the linked-to page. However, contrary to the Examiner's assertions, selection of the hyperlink does not satisfy generating a search query using the selected groups of characters in response to selecting a search object.

Kleinberg additionally discloses (col. 4, ll. 44-52, and col. 7, ll. 25-30) beginning with a single page including content of interest, obtained as a result of a keyword-based query, and forming an initial set including the single page and all pages linked to or from the page. Kleinberg discloses (col. 7, ll. 31-37) that an initial set of pages including a query string may be obtained using a term-matching algorithm. In other words, the set of pages linked to or from the single page of interest is searched to obtain the set of pages that are linked to or from the single page and also include the search query. Next, for each page in the set, the number of links to or from the page is determined, and the authoritativeness is calculated by scoring the page according to the determined number (see col. 4, ll. 53-65). In other words, Kleinberg discloses finding links to or from a document but not highlighting words in the document and using those words to generate a search query, as required by each of independent claims 1 and 20 through

¹ Based on our knowledge of Google today, we take as "selecting a search object" to mean, for example, selecting, after right clicking on the document, a menu item that reads "search."

24. Accordingly, Kleinberg fails to anticipate claims 1, 3 through 7, 9 through 12, and 14 through 24.

Independent claims 25 and 42 through 44 each recite identifying a document with one or more links, determining a score for each link, and prefetching a number of the linked documents. The Examiner asserts (Answer 7) that Kleinberg discloses (col. 4, ll. 44 and 53-65) determining an initial set of pages, counting links, and determining scores for the links, which steps correspond to the claimed prefetching, identifying links, and scoring the linked pages. Appellants contend (Br. 61-75) that Kleinberg does not disclose prefetching a number of documents based on calculated scores. The issue, therefore, is whether Kleinberg discloses calculating scores for linked documents and prefetching a number of the documents based on the scores.

In the portion relied upon by the Examiner, Kleinberg discloses beginning with an initial page that contains hyperlinks (which correspond to the claimed step of identifying a document with one or more links), obtaining an initial set of pages that includes the initial page and all of the pages linked thereto or therefrom, and performing an iterative process in which a score is calculated for each link (which corresponds to the claimed steps of analyzing each of the links and determining a score for each link). However, the step of obtaining the initial set of pages occurs before scoring each of the pages. Consequently, Kleinberg's obtaining an initial set of pages cannot correspond to Appellants' prefetching linked documents based on the determined scores. We find nothing in Kleinberg regarding prefetching documents based on the calculated scores. Thus, we cannot sustain the anticipation rejection of claims 25 through 33 and 35 through 44.

Claim 45, like claims 25 and 42 through 44, recites obtaining a document with one or more links, analyzing each link, and determining a score for each link. Instead of reciting "prefetching" a number of the documents based on the scores, though, claim 45 recites a client requesting and a server providing "a number of the linked documents ... based on the determined scores." However, since the preamble reads "[a] method for prefetching documents," the result of claim 45, the requesting and providing requested linked documents, appears to correspond to prefetching documents. Appellants contend (Br. 75) that Kleinberg fails to disclose requesting and providing a number of links based on the determined scores. The issue, therefore, is whether Kleinberg discloses requesting and providing links based on calculated scores.

As indicated *supra*, Kleinberg's step of obtaining the initial set of pages occurs before scoring each of the pages. Consequently, Kleinberg's obtaining an initial set of pages cannot correspond to Appellants' requesting and providing linked documents based on the determined scores, as suggested by the Examiner (Answer 7-8). Kleinberg discloses (col. 4, l. 66-col. 5, l. 3, col. 6, l. 65-col. 7, l. 2, and col. 7, l. 48-col. 8, l. 28) defining neighborhoods of pages from the calculated scores. Further, Kleinberg discloses (col. 7, ll. 16-20, and col. 9, ll. 37-42) that the user, at the beginning of the process, sets a maximum output size k , and at the end of the process, the k largest terms are output as results. However, Kleinberg merely outputs a list of the most authoritative documents, or the documents with the highest scores; Kleinberg does not disclose prefetching or requesting and providing a number of documents based on the calculated scores. Therefore, we will reverse the anticipation rejection of claim 45.

The Examiner rejects claims 2, 8, 13, 34, and 46 through 61 under 35 U.S.C. § 103 as being unpatentable over Kleinberg. Since claims 2, 8, and 13 depend from claim 1 and therefore contain all of the limitations of claim 1 which we found lacking from Kleinberg, and since the Examiner has provided no explanation as to why the missing limitations would have been obvious from the teachings of Kleinberg, we cannot sustain the obviousness rejection of claims 2, 8, and 13. Similarly, since claim 34 depends from claim 25 and thus includes all of the limitations of claim 25 which we found lacking from Kleinberg, and since the Examiner has provided no explanation as to why the missing limitations would have obvious from the teachings of Kleinberg, we cannot sustain the obviousness rejection of claim 34.

Regarding claims 46 through 61, Appellants contend (Br. 83-98) that Kleinberg fails to disclose identifying in a document a piece of information, determining a link to a related document by searching a set of documents for the identified information, and adding the link to the original document. The Examiner asserts (Answer 9 and 18) that "the list of most-recently visited Web sites corresponds to adding links to the Web page document being displayed." The issue is whether adding a link to a document would have been obvious from the teachings of Kleinberg.

Kleinberg discloses (col. 4, ll. 44-65 and col. 7, ll. 26-47) beginning with a document that contains subject matter of interest, creating a set of pages including the original document and all pages linked to or from the original document, and scoring the pages based on the number of links to or from each page. Thus, Kleinberg discloses identifying information of interest in a document and determining a link to a related document, but not by searching a set of documents for the identified information. Instead

Kleinberg finds related links by looking at the links to and from the original document. Furthermore, Kleinberg forms a set of authorities which includes the links, but does not disclose "adding the links to the document," as recited in claims 46 through 55 and 60, nor "providing the determined links with the document," as recited in claims 56, 58, and 61, nor "presenting the document with the determined links to a user," as recited in claim 57, nor "modifying, by the client, the requested document to include the links," as recited in claim 59. The Examiner asserts (Answer 9) that "the list of most-recently visited Web sites corresponds to adding links to the Web page document being displayed." However, even if we were to accept the Examiner's assertion, Kleinberg still fails to disclose determining a link to a related document by searching a set of documents for the information identified in an original document, and the Examiner has presented no explanation as to why the missing limitation would have been obvious. Accordingly, we cannot sustain the obviousness rejection of claims 46 through 61.

Under the provisions of 37 C.F.R. § 41.50(b), we enter the following new ground of rejection against Appellants' claims 1 through 24 under 35 U.S.C. § 112, first paragraph, as failing to meet the written description requirement. The phrase "search object" does not appear in either the originally filed claims or the originally filed Specification. As explained *supra* regarding the enablement rejection, we find no disclosure in the originally filed specification of selecting anything while characters are highlighted in a document and generating a search query in response to the selection. Therefore, the phrase "search object," which was added to the

claims by amendment,² is not adequately described in the originally filed Specification.

We also enter new grounds of rejection against Appellants' claims 7 and 8 under 35 U.S.C. § 112, first and second paragraphs, as failing to meet the enablement requirement and as being indefinite, respectively. Claims 7 and 8 depend indirectly from claim 1, and, therefore, include all of the limitations of claim 1. Since we have found that the term "search object" in claim 1 lacks enablement, and since nothing in claims 7 and 8 cures the enablement issue of claim 1, claims 7 and 8 lack enablement as well. Likewise, since we have found that the term "search object" in claim 1 is indefinite, and since nothing in claims 7 and 8 cures the indefiniteness issue of claim 1, claims 7 and 8 are indefinite as well.

ORDER

The decision of the Examiner rejecting claims 1 through 6 and 9 through 24 under 35 U.S.C. § 112, first and second paragraphs, is affirmed. The decision of the Examiner rejecting claims 1, 3 through 7, 9 through 12, 14 through 33, and 35 through 45 under 35 U.S.C. § 102 and claims 2, 8, 13, 34, and 46 through 61 under 35 U.S.C. § 103 is reversed. New grounds of rejection have been entered against claims 1 through 24 under 35 U.S.C. § 112, first paragraph, as failing to satisfy the written description requirement and against claims 7 and 8 under 35 U.S.C. § 112, first and second paragraphs, as failing to satisfy the enablement and definiteness requirements, respectively.

² See Amendment filed September 8, 2004.

Regarding the affirmed rejection(s), 37 C.F.R. § 41.52(a)(1) provides "Appellant[s] may file a single request for rehearing within two months of the date of the original decision of the Board."

In addition to affirming the Examiner's rejection(s) of one or more claims, this decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the Examiner, in which event the proceeding will be remanded to the Examiner. . . .

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should Appellants elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If Appellants elect prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART
37 C.F.R. § 41.50(b)

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HARRITY SNYDER, LLP
11350 Random Hills Road
SUITE 600
FAIRFAX, VA 22030